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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,696	11/09/2001	Yasuyuki Inoue	6920/OK024	7564

7590 01/27/2005
DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

TRIMMINGS, JOHN P

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,696	INOUE, YASUYUKI	
	Examiner	Art Unit	
	John P Trimmings	2133	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 1-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicant's amendment dated 8/27/2004.

Claims 1-5 were amended.

Claim 6 was added.

Claims 1-6 are pending.

Response to Amendment

1. In view of the applicant's changes to the Specification, the examiner has withdrawn all objections to the Specification and approves said changes.
2. In view of the applicant's changes to Figures 7 and 8, the examiner has withdrawn all objections to said figures and approves said changes.

Response to Arguments

3. Applicant's arguments filed 8/27/2004 have been fully considered but they are not persuasive. The applicant did not address the examiner's rejections of Claims 1-5 under 35 USC 103, only applicant's new dependent claim 6, consequently the examiner maintains the said rejections of Claims 1-5 as per the examiner's first office action.

As per new Claim 6:

The examiner has not found any teachings within the applicant's Disclosure that would support the claim, and thus the claim is rejected as set forth below under 35 USC 112 first paragraph.

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4. The examiner, in view of the amendments to all Claims 1-5 and new Claim 6 filed 8/27/2004, sets forth (below) additional rejections to the claims under 35 USC 112 second paragraph necessitated by said amendments to the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claim limits the Log Memory Address Counter as being decremented if it is determined that there is a "Fail" condition. This limitation is not supported in the applicant's application either by suggestion or by inference. The Disclosure only specifies a decrement of the Write Extension Counter under "Fail" conditions, which extends the incremental write of the Log Memory (see paragraphs [0052] and [0055] of Disclosure). Therefore, without any suggestion within the original application by the applicant of such a decrement of the Log Memory Address Counter, the claim is rejected as failing to comply with the written description requirement.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "said input data" limitation of line 5 is indefinite because the examiner does not know if the phrase refers to the generator above, or to data within the generator.

The "under input first measurement data conditions" limitation is indefinite because the examiner does not know what this phrase means.

The "with expected data" limitation of line 7 is indefinite because the examiner is not sure if it is "the expected data" or not.

The "said measurement data" limitation of line 7 is indefinite because the examiner is not sure if it limits the first measurement data or the measurement result data.

The "second measurement result data for a semiconductor test device" limitation in line 14 is indefinite because the examiner does not know if it is "the" or "a" second measurement, because it is not clear if this is a second semiconductor test device ("a") or is the same device ("the") of line 3 of the claim.

The "a failure" limitation in line 15 is indefinite because the examiner is not sure if this is the same failure as the implied "a failure" of line 8.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The "the failure" limitation of line 7 is indefinite because it is not clear which of the "a failure" antecedents in Claim 1 are being referred.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "the test device" limitation of line 4 is indefinite because it is not clear which of the two test devices in Claim 1 are being referred.

9. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "the associated data" limitation of line 3 is indefinite because it is not clear which of the two antecedents in Claim 1 are being referred.

10. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "the test semiconductor device" limitation of line 3 is indefinite because it is not clear which of the two test devices in Claim 1 are being referred. And, the "the associated data" limitation of line 4 is indefinite because it is not clear which of the two antecedents in Claim 1 are being referred.

11. Claim 6 recites the limitations "the semiconductor memory", "the second measurement" and "the second measurement result" in lines 3, 3 and 4 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

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12. In view of the amendments to Claims 1-5 and new Claim 6, the examiner would like to point to minor inconsistencies within the claims.

As per Claim 1:

The examiner believes line 8 should recite "... a pass or [a] failure ...".

The examiner believes line 14 should recite "... [a] second measurement result ...".

The examiner believes line 16 should recite "... [a] preset write termination condition[s] that terminate[s] ...".

As per Claim 2:

The examiner believes line 1 should recite "[A] The semiconductor test ...".

The examiner believes line 4 should recite "... the [preset] write termination ...".

The examiner believes line 6 should recite "... [a] measurement for ...".

As per Claim 3:

The examiner believes line 1 should recite "[A] The semiconductor test ...".

In the interest of clarity, "a pass or a failure" should be "pass or failure".

As per Claim 4:

The examiner believes line 1 should recite "[A] The semiconductor test ...".

As per Claim 5:

The examiner believes line 1 should recite "[A] The semiconductor test ...".

In the interest of clarity, "a pass or a failure" should be "pass or failure".

As per Claim 6:

The examiner believes line 1 should recite "[A] The semiconductor test ...".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Trimmings whose telephone number is (703) 272-3830. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (703) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John P Trimmings
Examiner
Art Unit 2133

jpt


Primary Examiner